

REMARKS

The Office Action asserted a restriction requirement and rejected the claims under 35 U.S.C. §§ 102 and 103. Applicants amended claim 23 and cancelled claims 26, 28-33 and 39. Claims 1-25, 27 and 24-38 remain. Applicants request that the Examiner reconsider and withdraw the restriction requirement and the rejections. A Petition for a one (1) month extension of time accompanies this Amendment as a separate paper.

Restriction Requirement

The Office Action asserted a restriction requirement between Invention I, claims 1-27 and 34-38, drawn to product tracking and identification controlled work operations, and Invention II, claims 28-33 and 39, drawn to maintenance, repair, overhaul and teardown methods. Due to the original presentation of Invention I for prosecution on the merits, the Office Action withdrew claims directed to Invention II from consideration. Applicants have cancelled claims 28-33 and 39 directed to Invention II, without prejudice, in favor of a divisional filing. Applicant requests that the Examiner reconsider and withdraw the restriction requirement.

Claim Rejections - 35 U.S.C. § 102

The Office Action rejected claims 1-14, 17, 18, 20, 21, 23-25, 27 and 34-38 as being anticipated by United States Patent Number 6,516,239 to Madden *et al.* ("Madden"). Applicants believe the rejection was improper and must be withdrawn.

With respect to claims 1-14, 17, 18, 20 and 21, Applicants reiterate the arguments made in the previous response. Specifically, Madden fails to disclose or to suggest the step of "generating a tag for affixing to [the] part" as recited in independent claim 1; the step of generating output from the computer that "a user reviews ... and handles ... accordingly" as recited in independent claim 6; the step of

“generating tailored work instructions” as recited in independent claim 12; and the step of “determining whether [the] second part disposition requires adjustment of [the] first part disposition” as recited in independent claim 14.

Mirroring the above discussion, Madden likewise fails to disclose or to suggest all of the features of claims 34-38. Specifically, Madden fails to disclose or to suggest the “means for generating a tag to affixing to [the] part” as recited in claim 34; the “means for generating output ... so that a user can review [the] output and handle [the] part accordingly” as recited in claim 35; the “means for processing ... to generate tailored work instructions” as recited in claim 36; and the “means for processing ... wherein [the] second part disposition may require adjustment to [the] first part disposition” as recited in claim 37.

With respect to claims 23-25 and 27, independent claim 23 now includes the feature recited in claim 26, now cancelled. Namely, claim 23 now recites, *inter alia*, that the part is a “gas turbine engine part.” As will be discussed in more detail in the next section, neither Madden nor any of the cited references provide a motivation for such a feature. Applicants request that the Examiner reconsider and withdraw the rejections.

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 15, 19, 22, 26, 28 and 29 as being unpatentable over Madden. Applicants assert that the rejection was improper and must be withdrawn. Specifically, the Office Action failed to establish a *prima facie* case of obviousness.

A *prima facie* case of obviousness must meet three basic criteria must be met. M.P.E.P. § 2143. First, there a suggestion or motivation must exist to modify the reference. *Id.* Second, the proposed

modification must have a reasonable expectation of success. *Id.* Finally, the reference must teach or suggest all the claim limitations. *Id.*

While M.P.E.P. § 2143.01 recognizes that a motivation can exist either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art, the Office Action failed to indicate any source for such motivation. For at least this reason, the rejection was improper and must be withdrawn. Applicants remind the Examiner that knowledge of the present Application must be put aside in reaching this determination, that impermissible hindsight must be avoided and that the obviousness conclusion must be reached on the basis of the facts gleaned from the prior art. M.P.E.P. § 2142. Applicants request that the Examiner reconsider and withdraw the rejection.

Conclusion

In light of the foregoing, Applicants submit that the claims are now in condition for allowance or at least in better form for appeal. In addition, the changes made herein do not necessitate a new search, raise the issue of new matter, present additional claims, or otherwise introduce new issues. Applicants request that the Examiner reconsider and withdraw the restriction requirement and the rejections. Applicants solicit the allowance of claims 1-25, 27 and 24-38 at an early date.

Respectfully submitted,



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